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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/714,359  | 11/14/2003  | Larry E. Moser       | 247-0039US          | 3336             |
| 29855   | 7590        | 05/20/2004           | EXAMINER            |                  |
| WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI,<br>P.C.<br>20333 SH 249<br>SUITE 600<br>HOUSTON, TX 77070 |             |                      | WALLS, DIONNE A     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1731                |                  |
| DATE MAILED: 05/20/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/714,359

### Applicant(s)

MOSER ET AL.

### Examiner

Dionne A. Walls

### Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) 1-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56,66,71,75,78,79 and 82-84 is/are rejected.
- 7) ☒ Claim(s) 57-65,67-70,72-74,76,77,80,81 and 85-104 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-33, drawn to a device for filling a cigarette tube having separate movable metering and compression members, classified in class 131, subclass 70.
  - II. Claims 34-55, drawn to a device for filling a cigarette tube having one member for moving and compressing loose tobacco, classified in class 131, subclass 70.
  - III. Claims 56-104, drawn to a method for filling a cigarette tube with tobacco, classified in class 131, subclass 70.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination, Invention II, requires that there be one moveable first member for moving and compressing the tobacco . The subcombination has separate utility such as moving, but not necessarily metering, loose tobacco from a hopper to a compression chamber.

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3. Inventions I,III and II,III are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of either inventions I or II can be used to practice another and materially different process, such as that for filling a casing material with meat, i.e. sausage making.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and the search required for Group II is not required for Group II, etc., restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Terril Lewis on Tuesday, May 4, 2004 a provisional election was made without traverse to prosecute the invention of a method for filling a cigarette tube with tobacco, claims 56-104. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 56, 66, 75, 78 and 84 are rejected under 35 U.S.C. 102(b) as being anticipated by Chaze (US. Pat. No. 2,551,095).

Chaze discloses all that is recited in the claims (Note: "scraper 10" corresponds to the means which enables the claimed "metering loose tobacco from a hopper to a compression chamber"; "pushing member 20" corresponds to the means which enables the claimed "compressing the loose tobacco in the compression chamber"; "transverse push rod" corresponds to the means which enables the claimed "injecting the compressed tobacco"; "pushing member 12" corresponds to the means which enables the claimed "biasing the loose tobacco downward in the hopper"; see entire document and figs.)

9. Claims 56, 71, 78 and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Josuttis et al (US. Pat. No. 4,572,216).

Josuttis discloses all that is recited in the claims (Note: The disclosure states that the tobacco in a chamber is cause to be seized and conveyed, automatically by a drive (corresponding to the claimed "motor"), through a rod grate and into a conveyor (corresponding to the claimed "metering loose tobacco from a hopper to a compression chamber") wherein it is then compressed and then firmly pushed (corresponding to the

claimed "injecting the compressed tobacco") into a cigarette paper shell; see cols 4 and 5, and figs.)

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 82-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaze (US. Pat. No. 2,551,095).

While Chaze may not specifically articulate a compression step including the affixing of a cigarette tube in communication with the compression chamber, or that said affixing occurs prior to the metering compression and injection steps, it follows that one having ordinary skill in the art would have opted to affix the tube at the point in the process that is deemed to be most convenient, and would have opted to do so either before or during the metering or compression steps in order to ensure proper placement for the receiving of tobacco for filling.

***Allowable Subject Matter***

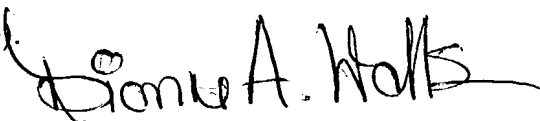
12. Claims 57-65, 67-70, 72-74, 76-77, 80-81 and 85-104 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dionne A. Walls  
Primary Examiner  
Art Unit 1731

May 13, 2004